



KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

MAILED

AUG 17 2010

OFFICE OF PETITIONS

In re Application of Dobie et al.	:	
Application No. 10/789,526	:	On Application For
Filing Date: February 26, 2004	:	Patent Term Adjustment
Attorney Docket No. BIOL0002US/ISIS.035A	:	

This is in response to the "Application for Patent Term Adjustment 37 C.F.R. § 1.705(b)" filed February 17, 2010. Applicants request the initial determination of patent term adjustment be corrected from fifty-three (53) days to two hundred thirty-five (235) days.

The request for reconsideration of the initial determination of patent term adjustment is **granted to the extent indicated herein**.

The Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) mailed with the Notice of Allowance on November 17, 2009, advised Applicants of a patent term adjustment to date of 53 days.

The petition asserts:

1. "[T]he PTA sent with the Notice of Allowance, 53 days, is inconsistent with the calculation listed on PAIR, which lists a PTA of 24 days;"
2. The period of Office delay under 35 U.S.C. § 154(b)(1)(A) ("A delay") is 161 days;
3. The period of Office delay under 35 U.S.C. § 154(b)(1)(B) ("B delay") is 211 days;
4. The period of delay under 35 U.S.C. § 154(b)(2)(C) ("Applicant Delay") is 137 days; and
5. The correct patent term adjustment is 235 days, which is the sum of 161 days of A Delay and 211 days of B Delay reduced by 137 days of Applicant Delay.

B Delay

To the extent applicants request reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the request is premature.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years.

See 37 C.F.R. § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the 37 C.F.R. § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 C.F.R. § 1.702(a)(4) or applicant delay under 37 C.F.R. § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 C.F.R. § 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature.

Rather than file an application for patent term adjustment under 37 C.F.R. § 1.705(b) contesting the 37 C.F.R. § 1.702(b) calculation at the time of the mailing of the notice of allowance, an applicant may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 C.F.R. § 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 C.F.R. § 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 C.F.R. § 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 C.F.R. § 1.705(d) and must include payment of the required fee under 37 C.F.R. § 1.18(e).

The November 17, 2009 Determination of Patent Term Adjustment and PAIR

The Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) mailed with the Notice of Allowance on November 17, 2009, advised Applicants of a patent term adjustment to date of 53 days. However, as recognized by Applicants, Office PALM records indicate the patent term adjustment is 24 days.

The Office has reviewed the record and determined the patent term adjustment is 24 days, which is 161 days of A Delay reduced by 137 days of Applicant Delay.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Conclusion

The patent term adjustment as of November 17, 2009, the date the Office mailed the Notice of Allowance, is 24 days.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is positioned above the printed name.

Anthony Knight
Director
Office of Petitions